UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,780	12/20/2001	Eyal Cohen	135.001US01	9593

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EXAMINER
WILLIAMS, JEFFERY L

ART UNIT	PAPER NUMBER
2137	

DATE MAILED: 02/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/027,780	COHEN, EYAL
	Examiner	**Art Unit**	
	Jeffery Williams	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on _29 November 2005_.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) _18-37_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) _18-37_ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☒ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on _29 November 2005_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All   b)☐ Some * c)☐ None of:

      1. ☒ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

1   **DETAILED ACTION**

2

3   This action is in response to the communication filed on 11/29/05.

4

5   All objections and rejections not set forth below have been withdrawn.

6

7   ***Specification***

8

9   **The specification is objected to as failing to provide proper antecedent**

10   **basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP**

11   **§ 608.01(o). Correction of the following is required:**

12

13   Claim 20 refers to the execution of a modified executable program file wherein

14   the executing includes the "self-decryption" of the modified executable program file and

15   the "self-decryption" of secured digital content. The specification does not provide

16   support for the "self-decryption" of a file, and the "self-decryption of digital content".

17

18   Claim 26 refers to "a signature key which performs content authentication". The

19   specification does not provide support for the existence of a signature key which

20   authenticates content.

1

2   *Claim Rejections - 35 USC § 112*

3

4   The following is a quotation of the first paragraph of 35 U.S.C. 112:

5   The specification shall contain a written description of the invention, and of the manner and process of
6   making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the
7   art to which it pertains, or with which it is most nearly connected, to make and use the same and shall
8   set forth the best mode contemplated by the inventor of carrying out his invention.
9

10   **Claims 20 and 26 are rejected under 35 U.S.C. 112, first paragraph, as**

11   **failing to comply with the written description requirement.** The claim(s) contains

12   subject matter which was not described in the specification in such a way as to

13   reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

14   application was filed, had possession of the claimed invention. See above objection to

15   the specification.

16

17

18   The following is a quotation of the second paragraph of 35 U.S.C. 112:

19   The specification shall conclude with one or more claims particularly pointing out and distinctly
20   claiming the subject matter which the applicant regards as his invention.
21

22   **Claims 20, 22, 23 – 28 are rejected under 35 U.S.C. 112, second paragraph,**

23   **as being indefinite for failing to particularly point out and distinctly claim the**

24   **subject matter which applicant regards as the invention.**

25

1   Claim 20 recites the limitation "wherein said executing" in line 1. There is

2   insufficient antecedent basis for this limitation in the claim. The referenced claim 18

3   includes both the general "executing" of a program file and a more specific "executing"

4   of software procedures, an extension of the general "executing" of the file. Thus, it is

5   unclear as to which "executing" the applicant is referring to, the broader "executing" of a

6   program file or the more specific "executing" of software procedures.

7

8   Claim 22 recites the limitation "said executable program module" in line 2. There

9   is insufficient antecedent basis for this limitation in the claim. The examiner will

10 presume the applicant to refer to "said executable program file".

11

12   Claim 24 recites the limitation "upon said executing" in line 2. There is

13 insufficient antecedent basis for this limitation in the claim. The referenced claim 18

14 includes both the general "executing" of a program file and a more specific "executing"

15 of software procedures, an extension of the general "executing" of the file. Thus, it is

16 unclear as to which "executing" the applicant is referring to, the broader "executing" of a

17 program file or the more specific "executing" of software procedures.

18

19   Claim 23, is rejected for reasons similar to claims 20 and 24.

20

21   Claims 25 – 28 are rejected by virtue of dependency.

22

1   *Claim Rejections - 35 USC § 102*

2

3   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

4   form the basis for the rejections under this section made in this Office action:

5   A person shall be entitled to a patent unless –

6   (e) the invention was described in (1) an application for patent, published under section 122(b), by
7   another filed in the United States before the invention by the applicant for patent or (2) a patent
8   granted on an application for patent by another filed in the United States before the invention by the
9   applicant for patent, except that an international application filed under the treaty defined in section
10   351(a) shall have the effects for purposes of this subsection of an application filed in the United States
11   only if the international application designated the United States and was published under Article 21(2)
12   of such treaty in the English language.
13

14   **Claims 18 – 37 are rejected under 35 U.S.C. 102(e) as being anticipated by**

15   **Candelore et al., (Candelore), "Secure Processor With External Memory Using**

16   **Block Chaining and Block Re-Ordering", U.S. Patent 6,061,449.**

17

18   Regarding claim 18, Candelore discloses:

19   *(a) designating a plurality of critical locations within the executable program file*

20   (28:27-38 – Candelore discloses the designation of locations within the file to be

21   modified for the protection scheme); *(b) arming the executable program file, thereby*

22   *producing a modified executable program file by including a plurality of software*

23   *procedures at said locations wherein each said software procedure performs at least*

24   *one linked portion of the securing* (25:20-28, 50-58 – Candelore discloses the "arming"

25   of the file by producing a modified executable file, wherein the file includes modified

26   software procedures at the designated locations to perform "linked" "securing"); *(c)*

27   *storing said modified executable program file in storage operatively attached to a*

1   *computer* (fig. 1, elem. 110); *and (d) executing in a computer said modified executable*

2   *program file, thereby executing said software procedures solely upon reaching said*

3   *respective locations (28:8-18).*

4

5   Regarding claim 19, Candelore discloses:

6   *wherein the securing includes at least one security function selected from the*

7   *group consisting of checking authenticity, checking validity and authorization (15:30-46).*

8

9   Regarding claim 20, Candelore discloses:

10   *wherein said executing includes self-decrypting said modified executable*

11   *program file and secured digital content accessible by said executable program file*

12   (15:28-45 – Candelore discloses a method for executing, wherein the method includes

13   decrypting ("self-decrypting", as the method for decrypting is part of the execution

14   method itself) the program file and secure content).

15

16   Regarding claim 21, Candelore discloses:

17   *wherein said arming includes storing in at least one of said software procedures*

18   *at least a reference to a key, wherein said key is required for accessing another of said*

19   *software procedures (20:5-35).*

20

21   Regarding claim 22, Candelore discloses:

1   *wherein said designating is performed by an owner of digital content accessible*

2   *by said executable program module (28:27-38).*

3

4   Regarding claim 23, Candelore discloses:

5   *(e) verifying an authentication key accessible over the internet* (11:36-51 – an

6   arrangement of bits, such as a key, is inherently able to be obtained from a medium,

7   such as the Internet. The descriptive language, being "accessible" or "able to be

8   accessed", clearly is applicable to any arrangement of bits, as bits can be transmitted

9   and received over the Internet. Furthermore, describing bits as capable of being

10   transmitted does not further limit structure and require that bits be transmitted).

11

12   Regarding claim 24, Candelore discloses:

13   *(e) upon said executing, accessing secured digital content stored on a digital*

14   *medium, wherein at least one key required for said accessing is stored on said digital*

15   *medium* (15:42-47 – the key and the secure digital content are found to be co-located

16   within the same medium).

17   .

18   Regarding claim 25, Candelore discloses:

19   *wherein said at least one key is required to decrypt said secured digital content*

20   (15:42-47).

21

22   Regarding claim 26, Candelore discloses:

1   *wherein said at least one key includes a signature key which performs content*

2   *authentication and a content key which is used to decrypt said secured digital content,*

3   *wherein said content key and said signature key are stored on said digital medium*

4   (15:42-47 – the key is both an "authentication key" (as the correct key will only decrypt

5   the correct content, thus indicating is the correct/authentic content was received) and a

6   content key (as it decrypts the content). The key and the secure digital content are

7   found to be co-located within the same medium).

8

9   Regarding claim 27, Candelore discloses:

10   *wherein said at least one key has at least one address stored solely in at least*

11   *one of said software procedures* (15:42-47 - The key's address, location of storage, is

12   derived from the "at least one of said software procedures").

13

14   Regarding claim 28, Candelore discloses:

15   *wherein said at least one key is provided by an address conversion module*

16   *stored on said digital medium* (15:42-47 – The key is found to be used by the system of

17   Candelore, thus the system inherently includes a module to find the location of the key).

18

19   Regarding claim 29, Candelore discloses:

20   *wherein at least one of said software procedures is encrypted using at least one*

21   *key* (25:20-28, 50-58; 28:8-18).

22

1   Regarding claim 30, Candelore discloses:

2   *wherein at least one of said software procedures receives at least a portion of a*

3   *key from at least one other of said software procedures (25:20-28, 50-58; 28:8-18).*

4

5   Regarding claim 31, Candelore discloses:

6   *wherein a key is determined by selectably either a specific location within said*

7   *software procedure or a calculation based on the software procedure, further*

8   *comprising the step of: (d) accessing another said software procedure using said key*

9   *(25:20-28, 50-58; 28:8-18).*

10

11   Regarding claim 32, Candelore discloses:

12   *wherein said software procedures are concealed within the executable program*

13   *file (26:14-24).*

14

15   Regarding claim 33, Candelore discloses:

16   *wherein said designating includes introducing flags within said executable*

17   *program file, wherein said flags designate said critical locations within said executable*

18   *program file (28:27-38 –* Candelore discloses that the program is divided into defined

19   structural boundaries, the boundaries indicating the location of secured blocks).

20

21   Regarding claim 34, Candelore discloses:

1   wherein portions of said executable program file are occluded by said software

2   procedures (25:20-28, 50-58; 28:8-18, 27-38).

3

4   Regarding claim 35, Candelore discloses:

5   *A digital storage medium including the modified executable program file*

6   *produced according to the method of claim 18* (fig. 1).

7

8   Regarding claim 36, Candelore discloses:

9   *A digital storage medium storing secured digital content accessible by a modified*

10   *executable program file produced according to the method of claim 18* (fig. 1).

11

12   Regarding claim 37, it is the computer medium and instructions claim

13   corresponding the method claim 18, and it is rejected, at least, for the same reasons.

14

15

16

17   ***Response to Amendment***

18
19   The declaration under 37 CFR 1.132 filed 12/14/05 is insufficient to overcome the

20   rejection of claims 1 – 17 based upon rejected under 35 U.S.C. 101 as set forth in the

21   last Office action because: the facts presented are not germane to the rejection at issue.

22   The applicant has canceled claims 1 – 17, and consequently, the examiner has

23   withdrawn the rejections of claims 1 – 17 under 35 U.S.C. 101.

1   ***Response to Arguments***

2

3   Applicant's arguments with respect to claims 1 – 17, and the newly added claims

4   18 - 37 have been considered but are moot in view of the new ground(s) of rejection.

5

6   ***Conclusion***

7

8   Claims 18 – 37 are pending.

9

10   The prior art made of record and not relied upon is considered pertinent to

11 applicant's disclosure.

12   See Notice of References Cited.

13

14   Applicant's amendment necessitated the new ground(s) of rejection presented in

15 this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP

16 § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

17 CFR 1.136(a).

18   A shortened statutory period for reply to this final action is set to expire THREE

19 MONTHS from the mailing date of this action. In the event a first reply is filed within

20 TWO MONTHS of the mailing date of this final action and the advisory action is not

21 mailed until after the end of the THREE-MONTH shortened statutory period, then the

22 shortened statutory period will expire on the date the advisory action is mailed, and any

1   extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

2   the advisory action. In no event, however, will the statutory period for reply expire later

3   than SIX MONTHS from the date of this final action.

4

5   Any inquiry concerning this communication or earlier communications from the

6   examiner should be directed to Jeffery Williams whose telephone number is (571) 272-

7   7965. The examiner can normally be reached on 8:30-5:00.

8   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

9   supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone

10   number for the organization where this application or proceeding is assigned is 571-

11   273-8300.

12   Information regarding the status of an application may be obtained from the

13   Patent Application Information Retrieval (PAIR) system. Status information for

14   published applications may be obtained from either Private PAIR or Public PAIR.

15   Status information for unpublished applications is available through Private PAIR only.

16   For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

17   you have questions on access to the Private PAIR system, contact the Electronic

18   Business Center (EBC) at 866-217-9197 (toll-free).

19

20   Jeffery Williams
21   AU: 2137
22

EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER